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Supreme Court, U.S.
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No. 03-1461

IN THE

Supreme Court of the United States

AVERY DENNISON CORPORATION,

Petitioner,

v.

3M INNOVATIVE PROPERTIES COMPANY and MINNESOTA MINING & MANUFACTURING COMPANY,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals For the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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COUNTER-STATEMENT OF THE QUESTIONS PRESENTED

1. Whether the U.S. Court of Appeals for the Federal Circuit, in construing the claims of 3M's patent, properly considered a passing statement by the patent examiner, which was not an "action, finding or conclusion" of the Patent Office, and which by law could have no relevance to the patentability of the claims, in determining the meaning of claim terms explicitly defined by 3M in its patent.

2. Whether the Federal Circuit properly determined that the terms "embossed" and "multiple embossed pattern" in 3M's patent claims referred to the topography of the claimed product, and did not require that the product be made by a particular process, where:

(a) under the Federal Circuit's long precedent, the claim language did not require a particular process;

(b) the patent's specification explicitly defined the relevant term in a purely structural manner;

(c) the patent's specification provided no basis by which a limitation not in the patent claims should have been imported into the claims;

(d) the disputed claim contained process limitations when the patent application was filed, and the patent applicants removed those limitations while prosecuting the application to the Patent Office; and

(e) the examiner comment, central to Petitioner's entire petition, was entirely unrelated to the reason the examiner allowed the claims to issue.

CORPORATE DISCLOSURE STATEMENT

Respondent 3M Innovative Properties Company is a wholly owned subsidiary of respondent Minnesota Mining and Manufacturing Company (now known as 3M Company). 3M Company has no parent company, and no publicly held company owns 10% or more of its stock.

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STATUTORY PROVISIONS INVOLVED

The appeal involves 35 U.S.C. § 112, which notes that the claims of a patent (and not other portions of the patent urged by Petitioner) define the scope of a patented invention, and § 271(a), which defines patent infringement. Ultimately, this appeal involves only patent claim construction, which is indirectly related to both provisions.

The appeal does not involve 5 U.S.C. § 706, which Petitioner has never before cited. This is not an appeal from an agency action, and there was no "agency action" here.

COUNTER-STATEMENT OF THE CASE

A. Introduction

No compelling reason exists to grant this petition. The case does not present a conflict among circuits, and the Federal Circuit has shown no internal disagreement on the questions Petitioner presents. (The dissent below was premised on other points.) Nor does the case present important questions of federal law that this Court should decide, or conflict with the relevant decisions of this Court.

This dispute simply involves a case-specific interpretation of two related terms in the claims of a 3M patent on graphic films, applied to the sides of trucks and buses. The process of interpreting the claims was not difficult because the inventors explicitly defined the claim terms in their patent. While the dissent below viewed the definition differently than did the majority, the dissent never agreed with Petitioner's current position that the claim was in a "product-by-process" format, that the claim language itself required process limitations, or that there was some "agency action" that is entitled to some level of judicial deference. Even Petitioner admitted at oral argument to the appellate court that the claim was not in "product-by-process" format, but instead

contained "process like" elements. And no one, not even Petitioner, ever asserted or even alluded to the APA or to any rule of deference. Instead, until the petition to this Court, all parties and the court worked under the well-settled rules of patent claim construction (though they differed on how the construction should come out, based on the facts).

B. The 3M Invention and Patent

3M's patented adhesive graphics film kills two birds with one stone: it allows an installer to reposition the film during installation (*i.e.*, to straighten the film or remove wrinkles), and it allows the installer to remove air bubbles easily once the film is set in position. *See* U.S. Patent 5,897,930. The invention solves the first problem by providing nonadhesive bumps that stick out from the adhesive on the back of the film so that, until the film is pressed down, it floats up on the bumps over the surface on which it is to be applied. [A487-88][1] The invention solves the second problem (*i.e.*, getting air bubbles out of the applied film) by providing small indented channels in the adhesive through which air can flow after the film is applied to get air bubbles to the edge of the film. [*Id.*]

To place these features in the film/adhesive, the 3M invention starts, not with the film or adhesive, but with the sheet that covers the adhesive and that is peeled away by the installer. This backing is known as a "release liner." [*Id.*] Specifically, 3M's invention comprises a release liner having two superimposed embossed patterns of differing depths—a "multiple embossed pattern." [*Id.*; A48(col. 9, line 34)] Such a structure (greatly magnified) is shown in Figure 3 of the patent (below).

---

[1] The Appendix submitted to the Federal Circuit is cited by page number as Axxx.

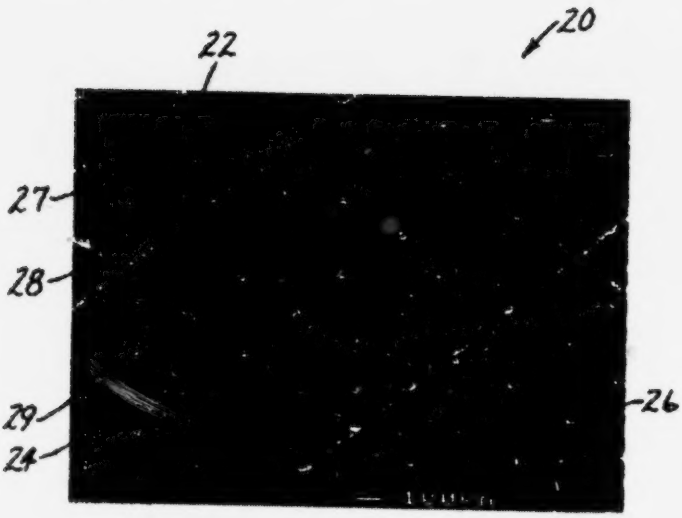

FIG.3

[A43, 45-46(col. 4, lines 66-67)] The liner in this figure has a number of intersecting "ridges" (28). When the liner is pressed onto the back of the film/adhesive, the ridges create corresponding air-release channels in the adhesive. [A487-88] The liner also contains a number of depressions (the dots in the photo) that correspond to the repositioning bumps on the film/adhesive. This liner, or "carrier web," is the structure that the 3M patent recites in the patent claims, and it is the structure by which the Federal Circuit construed the claims.

The 3M inventors left no doubt that the claim terms they used to describe this structure—"embossed," "pattern," and "multiple embossed"—were purely structural, because they chose to be their own "lexicographers" in the patent specification, a well-accepted practice in the patent field.[2] In par-

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[2] *See, e.g., Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984); *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 137 F.2d 3, 6 (7th Cir. 1943) ("Plaintiff's right to define the term used in its patent is clear."), *aff'd*, 322 U.S. 471 (1944).

ticular, the inventors explicitly defined each term in the specification using structural language:

> "Embossed" means a topography on a web or on tooling having an effective three-dimensional pattern that generates a difference in surface planar dimension in the liner or the tooling.
>
> . . . .
>
> "Pattern" means any formation of embossings that can utilize any theory of geometry, including without limitation, Euclidian geometry and fractal geometry.
>
> . . . .
>
> "Multiple embossed" means two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing.

[A44 (col. 1, line 61 to col. 2, line 3)] No definition recites any steps or process by which the defined structures must be created. It is these definitions that the Federal Circuit majority, following years of consistent case law allowing an applicant to be his own lexicographer and define his patent terms, adopted.

C. Prosecution of the 3M Patent

Before the Patent Office, the inventors originally presented patent claims that ***were*** limited to a process having separate, sequential embossing steps. However, after the patent examiner initially rejected the application, the inventors removed that requirement, as shown in the following amended claim 1 of the application, with added language underlined and deleted language stricken:

1. (Amended) A carrier web, comprising:

at least one surface that has a multiple embossed pattern having a first embossed pattern and a second embossed pattern ~~is multiple, sequentially embossed with a pattern,~~ wherein depressions of ~~created from~~ the first embossed ~~prior embossing~~ pattern are ~~patterns(s) are substantially preserved during~~ in the second ~~subsequent embossing pattern(s)~~ embossed pattern ~~even though the subsequent embossing pattern(s) are superimposed on the depressions from the prior embossing patterns(s)~~.

[A110] The inventors removed the requirement for "sequential" steps, removed the requirement that depressions be "created from the prior embossing," and removed the requirement for a "subsequent embossing." Instead, the inventors, post-amendment, simply recited the "carrier web" structure, apart from the process by which it was created. The inventors also pointed out in their comments that the new claim terms—"multiple embossed" and "pattern"—were "defined terms" in the patent, thus pointing up their intent to be lexicographers. [A111]

Notwithstanding the inventors' amendment of claim 1 to eliminate the sequential process language, the patent examiner, in a subsequent communication, referred to claim 1 as "drafted in the product-by-process format." [A121] The examiner's statement is curious because, under longstanding case law and Patent Office rules, process steps in a "product-by-process" claim are not to be considered for determining patentability, so the examiner could not have considered whether process steps in claim 1 distinguished the prior art, even if he was convinced they were there. Even with this additional inconsistency, two things are clear: the applicants never agreed to or acquiesced in the examiner's misstatement, and the characterization of the claim format had nothing to do with the examiner's ultimate allowance of the

claims. Rather, the claims issued only after the applicants added limitations defining the height of the ridges over the land. The examiner identified that structural height addition as the sole basis for allowing the claims to issue. [A133]

During the prosecution, the inventors presented another claim—claim 6—that recited a method or process of embossing and did include certain of the process steps that had been eliminated from claim 1. [*See* A48] Claim 6 has not been asserted in this case, but it underscores that the inventors used process language when they wanted to claim a process (claim 6), and structural language when they wanted to claim an apparatus (claim 1).

D. The District Court Rulings

Shortly after Respondents filed their Complaint in this action, they moved for a preliminary injunction. Petitioner argued that claim 1, although reciting a "carrier web" as a product, should be limited to a carrier web that had been formed using multiple, sequentially embossed patterns. [A971-72] For their part, Respondents pointed out that the patent specifically defines the relevant claim terms in a purely structural manner, that the patent specification distinguishes between "multiple embossed" patterns as a structure, and "multiple, sequentially embossed" patterns produced by the sequential method of unasserted patent claim 6, and that the inventors had removed the "sequential" limitation from claim 1 while prosecuting the patent application. [A1206-08] Nonetheless, the district court accepted Petitioner's argument that the embossed patterns had to have been applied sequentially rather than in one step.

After discovery, Petitioner moved for summary judgment that it did not infringe claim 1. Respondents reiterated their disagreement with the district court's earlier ruling, and identified disputed fact issues even under the district court's

construction. The district court granted Petitioner's motion, stating that it was applying its earlier construction of the relevant claim terms. [Pet. App. 31a] However, the district court actually stated a number of different constructions: it purported to apply the structural definition the inventors wrote in their patent, but it then added a requirement that the topography of the claimed carrier web be created by "impressing a corresponding inverse topography" on the web—a requirement found nowhere in the claims or the inventors' definition. [Pet. App. 32a] The district court then relied on several dictionary definitions, none of which said anything about "impressing" a topography. [Pet. App. 33a-34a] Stranger yet, the district court noted that it was applying its construction from the preliminary injunction proceedings—a definition that did not match the definitions in the patent and that did not require any "impressing."

E. The Federal Circuit Ruling and Denial of Rehearing

The Federal Circuit reversed the district court after holding that the district court improperly imported process limitations into claim 1. The Respondents, in briefing and arguing the appeal, again pointed out that the inventors provided clear definitions of the relevant terms in their patent, and that those definitions should control. For its part, Petitioner focused on alternative grounds for affirming the district court's claim construction. Petitioner argued that the inventors had not adequately shown their intent to define terms such as "embossed." Petitioner also argued that Respondents' proposed construction would make the term "embossed" in claim 1 superfluous, because claim 1 also recites a "pattern . . . of depressions" and a "pattern compris[ing] lands and ridges." But at most, these phrases simply cause some overlap between elements. Such overlap is common and allowable.

Importantly, Petitioner said nothing before the district court or the Federal Circuit about "deference" owed to any "decision" by the Patent Office, and said nothing about the Administrative Procedures Act (APA). At most, Petitioner suggested that the examiner's misdirected statement about "product-by-process" claims was, as part of the intrinsic patent record, relevant to determining the meaning of the claim terms. More important, at oral argument, Petitioner's counsel abandoned even that argument, and asserted only that the claim contained process-like limitations (emphasis added):

> Judge Clevenger: Does the definition [in the patent specification] say anything about how the depression gets created?
>
> Mr. Dorman: Does the…
>
> Judge Clevenger: ..is it punched up from the bottom..
>
> Mr. Dorman: what..no…no…no…
>
> Judge Clevenger: ..or punched up from the top, or [inaudible] go in and blow air in..
>
> Mr. Dorman: This was not a … ***I don't think this was a product-by-process claim***, pursuant to this, but I do think the word embossed…
>
> Judge Clevenger: Did you tell us that in your brief?
>
> Mr. Dorman: Yes, we, in the reply brief, we talked about, we cited *In re Fitzgerald*…
>
> Judge Clevenger: ***Did you tell us it was not a product-by-process claim***?
>
> Mr. Dorman: ***We explained that it was process-like in terms of***…
>
> Judge Clevenger: ***Right, but the district court said it was a product-by-process claim***.

> Mr. Dorman: ***What the judge said below is not determinative of what this court…***
>
> . . . .
>
> Judge Clevenger: I thought you said it was a process…[sic, product-by-process]
>
> Mr. Dorman: It is process-like.
>
> ....
>
> Judge Clevenger: And I guess I should have figured out that that's what you meant when you were citing In re Fitzgerald in footnote 5 on page 31 in your brief; or were you citing Fitzgerald for a different proposition?
>
> Mr. Dorman: Your honor, I apologize for not making this argument clearer. I mean, it's… The ah… But this is….

Petitioner's latest change in theory is thus new to the extent it raises the APA, and contrary to its earlier positions to the extent it argues the claims are in "product-by-process" format.

The Federal Circuit majority, in reaching its decision, started with the claim language as read in light of the patent specification and prosecution history. [Pet. App. 10a] The majority first found error in the district court decision that the recitation of "first" and "second" embossed patterns in the claims required that the patterns had to be formed in sequence. [Pet. App. 11a] The court then recognized that the applicants had defined the claim terms in the patent, and cited case law indicating that such explicit definitions control the claim construction process. [Pet. App. 15a]

The majority also considered the entirety of the prosecution file, including the examiner's misguided comment. [Pet. App. 15a-16a] The majority recognized the interpretive importance of the claim amendment by which the inventors broadened claim 1 to remove any process limitations. [Pet.

App. 13a] And the majority recognized that the examiner's comment, "[i]n this context," could not override the clear meaning of the claims, since the applicants never acquiesced in the comment, and the examiner allowed the patent to issue for reasons unrelated to the comment. [Pet. App. 15a-16a] Thus, the majority based its decision on the particular statements in the patent record and discerned the claim meaning from the entirety of those statements—a case-specific ruling.

The dissent did not suggest that certain deference was owed to the examiner. Rather, the dissent believed that the patent's definition of "multiple embossed," which spoke of "superimposed" patterns, suggested some process. [Pet. App. 21a] The dissent also did not go as far as the district court, which held that the claim was in product-by-process format and included a sequential limitation. Instead, the dissent simply noted that the claim required some process, and noted that the definition of "multiple embossed" did ***not*** require the tools to be applied serially rather than simultaneously. [Pet. App. 22a; Pet. at 13 n.8 (criticizing the dissent)] Thus, even the dissent did not adopt the positions urged by Petitioner here.

Petitioner then moved for *en banc* rehearing, a request that the court denied without any comment or opinion.

REASONS FOR DENYING THE PETITION

I. The Petition Does Not Identify Any Questions that Warrant the Court's Consideration

A. Petitioner Identifies No Basis For Review

This is an ordinary patent case, involving a patent-specific claim construction, that does not fit any of the examples of compelling reasons for a writ of certiorari given in Rule 10 of this Court. There is no circuit split, and there has been no disagreement within the Federal Circuit itself over

the questions Petitioner presents. The issues Petitioner raises, in fact, have nothing to do with any claim construction issue that has caused debate at the Federal Circuit, or with any of the issues discussed in the authorities that Petitioner cites.[3] Also, Petitioner does not argue that the Federal Circuit "has so far departed from the accepted and usual course of judicial proceedings" to warrant this Court's attention, and this appeal is not from a state court of last resort. Sup. Ct. R. 10(a), (b). Finally, the petition does not present a decision on an important question of federal law or on an important federal question. *Id.* 10(c). Petitioner's attempt to paint an ordinary patent case as an administrative law decision, or as establishing a controversial new rule of law, does not demonstrate a compelling reason to grant a writ of certiorari.

B. The Supposed "Agency Action" Here is a Fiction Created to Obtain Certiorari

This case is about patent claim construction in a suit between private parties. It has nothing to do with deference due

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[3] Petitioner's citation of authority is misleading. For example, Petitioner claims, without citation, that the Federal Circuit's claim construction reversal rate is nearly 50%. [Pet. at 2] However, one authority cited elsewhere by Petitioner indicates that between April 1996 and January 2001, the Federal Circuit rejected one or more of a district court's claim constructions in only 33% of cases, and only 81% of those cases were reversed or remanded. [Pet. at 14 n.9, citing Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases*, 12 Fed. Cir. B.J. 1, 10-11 (2002)] Another of Petitioner's sources indicates that, between January 1998 and April 2000, the Federal Circuit reversed 29.6% of cases in which the court expressly reviewed claim construction (excluding Rule 36 decisions, which are all affirmances). Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 Berkeley Tech. L.J. 1075, 1104 (2001).

to administrative agencies. The Federal Circuit was not reviewing a new Patent Office policy or statutory interpretation, nor was it reviewing a decision of the Board of Patent Appeals and Interferences or the Trademark Trial and Appeal Board. Rather, a Patent Office employee simply made a statement, akin to dicta, during the course of examining a patent application. The Federal Circuit considered this statement, as well as other statements made by the examiner and the applicant, and decided how the claims should be construed. The Federal Circuit based its claim construction on all of the evidence it normally considers when interpreting claims. At bottom, Petitioner's complaint is with the outcome of the case, based on its facts as viewed under the court's application of well-settled law, an issue not deserving of this Court's scarce resources.

1. Petitioner Never Raised This "Deference" Issue Before the District Court or Federal Circuit

Petitioner never mentioned the APA or deference to an administrative agency at the Federal Circuit or the district court. Instead, Petitioner properly treated the issue as one of claim construction, as did the courts. Petitioner's failure to even mention, let alone argue, the question of deference under the APA waived its opportunity to ask this Court to consider the issue. *See, e.g.*, *TRW Inc. v. Andrews*, 534 U.S. 19, 33-34 (2001) (rejecting an argument raised for the first time at the Supreme Court because it was not raised or briefed in the lower court); *United States v. Ortiz*, 422 U.S. 891, 898 (1975) (refusing to consider issue raised for first time in petition for certiorari).

Moreover, there is no rational reason that this Court should be the first ever to address the point. Neither the Federal Circuit nor the district court has considered this issue, as neither was given the opportunity to do so by the Petitioner. Petitioner's actions in this case thus simply underscore that

the APA deference issue is a straw man built to secure review of a patent-specific, fact-specific, case-specific ruling.

2. The Examiner's Statement Was Not and Could Not Be an Agency Decision or Finding in Any Event

A patent examiner is charged with determining the patentability of inventions under the Patent Office's guidelines. The examiner's offhand statement here could not be a decision or finding, because it was not related to the patentability of the invention. First, as a legal matter, examiners may not consider process steps in determining the patentability of product-by-process claims. Manual of Patent Examining Procedure (MPEP) § 2113 (citing *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985)); *see also Atl. Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845-46 (Fed. Cir. 1992); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1583 (Fed. Cir. 1991). Thus, contrary to Petitioner's repeated attempts to convince the Court that the examiner's statement here was substantive, the statement could not have been. Even if the examiner had decided the claim was in product-by-process format, he could not have used the process limitations to distinguish the prior art. *See Hyatt v. Boone*, 146 F.3d 1348, 1355 (Fed. Cir. 1998) (examiners are presumed to have done their jobs correctly and to have followed all Patent Office rules).

The examiner, in fact, did not allow the claims based on any conclusion about their format. Rather, he provided an explicit explanation on a paper entitled Notice of Allowability, explaining that his basis for allowing the claims related to the claimed heights of the lands and ridges:

> The reasons for withdrawing the rejections of record are as follows: The prior art does not suggest or teach a carrier web with ridges and land that ranges from about 3 to 45 μm.

[A133] Thus, the examiner relied purely on structure, not any view on claim format, in making his determination of patentability.

Apart from the fact that the examiner could not and did not make a decision or finding on claim format, a single comment of a patent examiner is not an "agency action" subject to deferential review. Section 706 of the APA sets the standards governing the scope of a court's review of agency fact-finding. Section 706, which applies to "agency action," states that "the reviewing court shall decide all relevant questions of law." 5 U.S.C. § 706. Section 551(13), a provision ignored by Petitioner, defines "agency action" as "the whole or a part of an agency rule, order, license, sanction, relief, or the equivalent or denial thereof, or failure to act." 5 U.S.C. § 551(13). For example, the decision of the Board of Patent Appeals and Interferences on appeal in *Dickinson v. Zurko* was an agency action. 527 U.S. 150 (1999). Section 706 is not meant to, and does not, apply to a single statement of an agency employee.

Not all undertakings by an agency are "agency actions." For example, the Patent Office's advertising campaign regarding invention promotion scams—an "action" that was more agency-wide, thought-out, and final than the examiner comments here, was not a final agency action subject to review under the APA. *See Invention Submission Corp. v. Rogan*, 357 F.3d 452, 459 (4th Cir. 2004) ("[T]he Administrative Procedure Act does not provide judicial review for everything done by an administrative agency . . . ." (internal quotation omitted)). Importantly, statements of lower-level agency officials are not agency actions subject to judicial review, even when contained in official administrative correspondence. *See Genendo Pharm. N.V. v. Thompson*, 308 F. Supp. 2d 881 (N.D. Ill. 2003). And comments made by agency employees in internal agency documents are not agency actions. *United States v. Farley*, 11 F.3d 1385, 1391 (7th Cir. 1993). Thus, the examiner's passing statement here,

which was part of a voluminous file, and was only one of many comments by the examiner, was properly considered by the Federal Circuit majority along with other intrinsic evidence in the context of construing claim 1, but it was not a Patent Office action entitled to some level of deference.

In contrast, the Federal Circuit applies deferential review when it is appropriate—to actual findings by the Patent Office, in the form of decisions by the Board of Patent Appeals that review decisions by an examiner. *See Dickinson*, 527 U.S. 150. As for review of issued patents, like that here, Congress has explicitly stated in the Patent Act that patents are presumed to be valid. 35 U.S.C. § 282. Implementing the statute, the Federal Circuit has required clear and convincing evidence of invalidity—thus granting deference to the examiner's decision to validate the issued patent. The Federal Circuit, however, has properly distinguished the examiner's action of issuing the patent from an examiner's passing statements, effectively dicta, during the examination process. *See Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1329 (Fed. Cir. 2000) (holding that the district court was not bound by patent examiner's statement, and distinguishing *Zurko* as an appeal from a Patent Office decision). Thus, the Federal Circuit does apply deference when and how it is appropriate. It is not appropriate here.

Petitioner also provides no authority to support its argument that *Zurko*, a direct appeal of a Board of Patent Appeals decision, should be applied to patent infringement litigation between private parties. Sections 704 and 706 of the APA apply to judicial review of an agency action. *See* 5 U.S.C. §§ 704, 706. Section 704 sets out the actions that are subject to judicial review. Section 706 requires a court to examine agency findings of fact carefully before substituting its judgment for that of the administrative agency with expertise in the respective subject matter. A court construing patent claims in an infringement action is not reviewing a Patent Office action to determine whether the agency's statements

about claim construction were appropriate, nor is it substituting its judgment for a decision within the expertise of the Patent Office. Rather, the court is performing the legal process of interpreting the patent document.

Petitioner notes that "patent claim construction has been analogized as a close cousin to statutory interpretation" and quotes *Chevron* at length. [Pet. at 24, quoting *Chevron U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837 (1984)] In *Chevron*, however, this Court "held that a court must give effect to an agency's regulation containing a reasonable interpretation of an ambiguous statute." *Christensen v. Harris County*, 529 U.S. 576 (2000) (holding that an agency opinion letter did not warrant *Chevron*-style deference). The analogy supports Respondents rather than Petitioner. Here, there is no statute that Congress has given the Patent Office authority to interpret. Thus, *Chevron* deference would likely be inapplicable even if the Patent Office adopted a rule on how to construe claims. Deference is plainly inapplicable where the "action" was by an agency staffer, was at most dicta by the staffer, and was not taken under any statute, let alone an ambiguous statute. Thus, there is no practical reason for the Federal Circuit to defer on a legal issue like claim construction.

II. The Federal Circuit's Decision Was Proper Under Any Standard

In stating its second Question Presented, Petitioner misrepresents the decision below. The Federal Circuit did not create a new rule of claim construction. Specifically, it did not hold that past tense verbs must be construed as entirely structural. Rather, the majority did nothing other than examine the claim language in the context of the intrinsic patent record:

> [W]ords of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural senses [sic, sense], unless the patentee has demonstrated otherwise.

[Pet. at 12 (quoting Pet. App. 11a)] The majority then examined the patent specification and file history, and concluded that no one had "demonstrated otherwise." Petitioner's attempt to divine a new rule of claim construction from this case-specific reading of the claim terms and review of the patent file again points up that Petitioner is simply recasting this case into something new.

Apart from this statement, the majority followed standard rules of claim construction that hold a patentee to statements made during prosecution that mattered to patentability, but ***not*** to offhand comments. The examiner here could not, and did not, base his allowance of the 3M patent on the presence of any process steps. And contrary to Petitioner's repeated assertion that the majority "wholly ignored" the examiner's statement, the majority explicitly discussed the statement and considered it in the proper context of the patent file to determine that it could not override the plainly structural nature of the patent claim. [Pet. App. 15a] The Federal Circuit's decision was thus fully consistent with its practice of looking at all the intrinsic evidence from the patent file to determine the proper meaning of the claims. *See, e.g., Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341-43 (Fed. Cir. 2001); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991).

Importantly, in support of its second issue, Petitioner has not cited a single decision of this Court, and has not identified any Federal Circuit decision that conflicts with the majority's approach. Rather, Petitioner simply contends that

some cases cited by the majority do not support the majority's conclusion. [Pet. at 26-27] Likewise, even the dissent below only criticized the majority's review of the facts; the dissent did not cite a single case. [Pet. App. 19a-23a] Petitioner's complaint ultimately boils down to its position that the majority misread the patent-in-suit—a complaint with the application of settled law to specific facts, and not an issue on which this Court should spend its limited resources.

CONCLUSION

For the foregoing reasons, Respondents respectfully request that the Court deny the petition for a writ of certiorari.

Respectfully submitted,

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